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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,039	12/20/2000	Gunther Michael	32301W090	6197

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EXAMINER

METZMAIER, DANIEL S

ART UNIT	PAPER NUMBER
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1712

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DATE MAILED: 05/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/740,039

Applicant(s)

MICHAEL ET AL.

Examiner

Daniel S. Metzmaier

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 May 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: for the reasons of record. Please see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1,2,4-8,10 and 11.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Daniel S. Metzmaier
Primary Examiner
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DETAILED ACTION

Claims 1-2, 4-8 and 10-11 are pending. This Action is responsive to the After Final Amendment filed May 15, 2003, Paper No. 15, with a three month extension of time, Paper No. 14.

Response to Arguments

1. Applicant's arguments filed May 15, 2003 have been fully considered but they are not persuasive.

2. Applicants (page 2 of May 15, 2003 response) assert the Klinge et al reference does not anticipate the claimed invention because the Klinge et al reference teaches Aerosil R 972, which has been stated by applicants to be a product made hydrophobic by treatment with dimethyldichlorosilane and identified as dimethyldidioxsilane on page 3 of the August 6, 2002 amendment. This has not been deemed persuasive for the following reasons:

(1) Initially, two separate issues exist regarding in the first instance (i) the compositions. As noted in the Claim interpretation section of the Final Office Action, "the determination of patentability is based on the product itself" for products drafted in product by process format. Attention redirected to MPEP 2113. In the instant case, the claims require products that have been hydrophobicized by reaction with a halogen-free silane. Applicants identify the Aerosil R 972 product as made hydrophobic dimethyldidioxsilane. Said dimethyldidioxsilane is not a conventionally use term of the art including patent literature, CAS Online or JPO, EPO, and Derwent abstract database. To the extent said material is a dimethyldioxysilane ($(\text{CH}_3)_2\text{-Si-(O}^-\text{)}_2$) or

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$(\text{CH}_3)_2\text{-Si=O}_2\text{=Si-CH}_3)_2$, said term proves the examiner's first position that the hydrophobing species is not a halo-silane.

Furthermore, paragraph number 11 from the Final Office Action is herein reproduced: "Applicants argue (pages 3 and 4) the Klinge reference does not disclose each and every element of the claim. Applicants are directed to MPEP 2113 wherein a product is examined based on the product that results and not the method that said product is made. There is no indication that the R 972 product formed with dimethyldichlorosilane would not be substantially complete. Chlorosilanes are readily hydrolyzed in aqueous environment and is further self catalyzed by said hydrolysis and HCl formation. Essentially 100 % hydrolysis would have been expected a providing the same or substantially the same product as claimed.

Furthermore, once a material appearing to be substantially the same, the burden shifts to applicant to show a difference and/or an unobvious difference. No such showing is set forth in the record."

(ii) Furthermore, the prior art record is unclear as to what the hydrophobing agent is regarding Aerosil R 972, dimethyldioxsilane or dimethyldichlorosilane. Applicants have stated the hydrophobing agent is dimethyldichlorosilane and said dichlorosilane is identified as dimethyldioxsilane.

3. Applicants (pages 2 and 3) assert the Burger fails to suggest the use of non-halogenated hydrophobicizing agents. Initially, the Burger reference discloses the use of Aerosil R 972. It therefore includes the issues discussed above regarding the Klinge reference.

Additionally, applicants' statement that Burger fails to suggest non-halogenated hydrophobicizing agents is incorrect. Burger (column 10, line 33-42 et seq) teaches typical hydrophobing agents including trimethylsiloxyl groups and siloxanes. Burger (line 66) discloses hydrophobic treatment with silicone oil. Burger (column 10, lines 49 et seq) characterizes the bulk density as 3.0 to 10.0 lb/ft³ (= 48-160 g/l). Burger clearly teaches and suggests the use of halogen-free hydrophobing agents.

4. Applicants (page 3) assert the Degussa AG (EP 0 808 880 A2) reference corresponds to US 5,959,005 employ additional steps in making the silicas. This has not been deemed persuasive for the following reasons: (1) regarding the compositions, the compositions otherwise read on the claims and the claims do not exclude the further steps.

(2) Regarding the methods, the method claims employ the open language, "comprising", and therefore do not exclude the additional method steps.

5. Applicants (pages 3 and 4) assert the Klingel reference lacks a teaching of halogen-free silane hydrophobing agents. This has not been deemed persuasive for the reasons set forth above.

Additionally, the Klingel reference is cited for conventional compacting treatment of the compositions and not for the particular material in the obviousness rejection.

Applicants (page 4) assert there exist no reasonable expectation of comparable results based on the substitution of different compaction methods. This has not been deemed persuasive since the Klingel reference teaches (examples) the use of the compression employing patentees roller compactor improves the stamping density over

conventional roller devices. Applicants do not support their conclusion that the substitution of different compacting means cannot be made with comparable results. Furthermore, said conclusion is inconsistent with the broad claim limitation that is open to any compacting means in instant claim 5.

6. The references further employ the same pyrogenic silica as a starting material, Aerosil 200. The substitution of the method step of Klinge and/or the materials in the Klinge method would have been a logical modification in view of the prior art. Klinge, with the exception of the example, is non-specific regarding the pyrogenic silicic acid that may be compacted by the methods disclosed therein. The only requirement is that the material be a pyrogenically produced silicic acid. Hartmann et al and EP 0 808 880 A2 disclose pyrogenic silicas having been hydrophobicized by a halogen-free silane.

7. The rejections in the Final office Action are deemed proper and have been maintained for the reasons of record. Applicants' arguments have been addressed hereinabove.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (703) 308-0451. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on (703) 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Daniel S. Metzmaier
Primary Examiner
Art Unit 1712

DSM
May 21, 2003